

REMARKS

Claims 1-60 are pending in the application. The Examiner has imposed a restriction requirement in this case. In particular, the Examiner states:

"This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Claims 1-8, 20-27, 39-47 and 58-60, drawn to a system and method for receiving an update schedule from a plurality of web sites and for providing the update schedule of selected sites to at least one consumer.
- II. Claims 9-13, 14, 17, 28, 29-33, 36, 48, 49-52 and 55, drawn to a system and method for recommending sites to the consumer based on the consumer's registration information and based on the consumer's interest as measured by the interest of members of the consumer's peer group (collaborative filtering).
- III. Claims 15-16, 18-19, 34-35, 37-38, 53-54 and 56-57, drawn to a system and method for placing advertisements in the web site update schedule forwarded to the user based on the consumer's or user's interest."

(Paper No.9, pg.2, first four paragraphs).

The Examiner goes on to state that the "inventions" of Groups I and II are related as *combination and subcombination*, and that "the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination is drawn to a system and method for recommending sites to the consumer based on the consumer's registration information and based on the consumer's interest as measured by the interest of members of the consumer's peer group (collaborative filtering)." (Paper No. 9, pg. 3, first paragraph). The Examiner further states that "[h]ence, the subcombination has separate utility." (*Id.*).

Applicants provisionally elect to prosecute Group I (including claims 1-8, 20-27, 39-47 and 58-60). This provisional election is made with traverse. That is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

1) The Examiner has Failed to Establish a Prima Facie Case for Restriction

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case for restriction.

a) Proper Basis for Restriction

i) Generally

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. (MPEP §802.01). The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". (MPEP §802.01). To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". (MPEP §808). The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". (*Id.*). To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". (MPEP §808).

ii) Combination and Subcombination

In some cases, claims may be directed to combinations, subcombinations, or elements of a combination. For restriction of combination and subcombination claims to be proper, "both two-way distinctiveness and reasons for insisting on restriction are necessary." (MPEP §806.05(c)). In particular, the inventions are distinct if the claimed combination (1) "does not require the particulars of the subcombination as claimed for patentability", and (2) "the subcombination can be shown to have utility either by itself or in other and different relations". (*Id.*). "Where these factors can not be shown, such inventions are not distinct." (*Id.*).

b) The Examiner's Case as Set Forth

The Examiner fails to provide *any* support for the present restriction. Instead, the Examiner makes the ambiguous statement that "the combination does not require the particulars of the subcombination as claimed because the subcombination is [the subcombination]." (Paper No. 9, pg. 2, last paragraph to pg. 3, first paragraph; the term "subcombination" substituted for the recited definition of the alleged subcombination as set forth by the Examiner). This statement does not satisfy the Examiner's burden of establishing a *prima facie* case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions. This statement also fails to establish a *prima facie* case for restriction of combination and subcombination claims.

Further, the Examiner fails to describe any basis for restriction between Groups I and III or Groups II and III. The Examiner makes no statement of any kind in support of the restriction between Groups I and III or Groups II and III.

c) Incorrect Basis for Restriction

The Examiner states that Groups I and II are related as combination and subcombination, and that Group II is the subcombination. (Paper No. 9, pg. 2, paragraphs 3 and 5). Applicants respectfully note, however, that the claims of Group II are all dependent upon various claims of Group I. In other words, the claims of Group I recite various elements (such as 'A' and 'B') and the claims of Group II recite the elements of Group I ('AB'), plus additional elements (such as 'C'). Accordingly, the claims of Group II (which recite elements 'ABC') can not possibly be considered to be subcombinations of the claims of Group I (which recite elements 'AB'). In other words, 'ABC' cannot be considered a subcombination of 'AB'. Further, no combination and subcombination relationship can be observed between any of the pending claims (note that none of the pending claims can be identified as AB or B; B being broad or narrow, as described in MPEP §806.05(c) I and II).

Applicants therefore respectfully submit that the Examiner has relied on improper grounds for imposing the present restriction requirement, and request that the restriction requirement be withdrawn.

d) A *Prima Facie* Case for "Distinct" Restriction has not been Established

No reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. (MPEP §808.02). Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." (*Id*).

e) A *Prima Facie* Case for "Combination and Subcombination" Restriction has not been Established

Even if the claims of Groups I and II were combination and subcombination claims, which Applicants assert they are not, the Examiner has not met the *prima facie* burden. For example, the Examiner has not shown "both two-way distinctiveness" or provided "reasons for insisting on restriction." (MPEP §806.05(c)). As described above, the Examiner provides no support for the allegations that the particulars of the subcombination are not required for patentability, or that the subcombination has separate utility. Nor does the Examiner provide adequate reasons for insisting upon restriction. In particular, the Examiner has failed to show how the examination of all pending claims would be unduly burdensome.

2) *The Examiner has Failed to Establish an Undue Burden*

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." (MPEP §803). Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged Groups

which would necessitate a separate field of search; (2) the alleged Groups can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged Groups are not related to any class of invention which has achieved a separate status in the art. (see, MPEP §808.02). In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Thus, even if the Examiner had set forth a *prima facie* case for restriction and had relied upon proper grounds for restriction, restriction would still not be proper in this case.

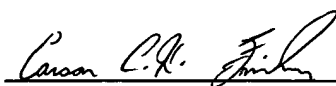
3) Conclusion

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. All claims currently remain in the case and are believed patentable. Applicants respectfully request allowance of the pending claims.

If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact Carson C.K. Fincham using the information provided below.

Respectfully submitted,

April 8, 2004
Date



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